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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,596	02/06/2004	John E. Soukeras		5104

7590

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EXAMINER

CHHABRA, ARUN S

ART UNIT

PAPER NUMBER

3764

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

TRM

<b>Office Action Summary</b>	Application No. 10/772,596	Applicant(s) SOUKERAS, JOHN E.	
	Examiner Arun S. Chhabra	Art Unit 3764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/28/2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                                    |

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the hollow handle that accepts the weights must be clearly shown in the drawings or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

The disclosure is objected to because of the following informalities: Line 24 in page 1 of the Specification, "providing" should be "provide"; Line 9 in page 3 of the Specification, the phrase, "I describe the embodiment of this invention," is confusing and perhaps unnecessary; Line 13 on page 3 of the Specification, "places" should be "placed".

Appropriate correction is required.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The term "extension" as claimed in claim 5 does not appear in the specification, more particularly in the area on page 6, lines 13-15 where the functionality of the structure seems to be discussed.

***Claim Objections***

Claim 1 is objected to because of the following informalities: "of" in the 1<sup>st</sup> line of claim 1 should be "or", "preferable" in the 2<sup>nd</sup> line of the claim should be "preferably".

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not

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described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The handle is not shown in the specifications or the drawings to be able to receive steel tubes or weights.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5, are rejected to as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Parentheses and quotes should be avoided. Note the format of the claims in the patent(s) cited.

There is no exact explanation in the specification of what the "curing" time is that is required after injection. Additionally there is a lot of unnecessary functional language in claims 1, mainly in lines 3, 4 and 6.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polk (U.S. Patent Number 257,929) in view of Daecher et al. (U.S. Patent Number 6,183,829).

Polk discloses the claimed invention except for the club being made out of plastic and the club's 2 mm wall thickness. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Indian club as taught by Polk, with plastic material since it was known in the art that plastic is used to provide flexibility, durability, and is of lighter weight and cheaper to make.

Daecher et al. teaches that it is known to use a minimal thickness of 1 mm when doing injection moldings as set forth in column 1, lines 56-66 to provide high orientation of fibers allowing for a more sturdy material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the club as taught by Polk, with an 2 mm wall thickness for injection molding as taught by Daecher, since such a modification would provide the club with an outer wall resistant to deformation or shrinkage.

Polk discloses the claimed invention but does not disclose expressly the "bee-hive" design and the dimensions of the handle and extension. It would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the club as taught by Polk with the "bee-hive" design and the dimensions set forth by the applicant. Applicant has not disclosed that a "bee-hive" design or the length and diameter of the handle and extension provide an advantage, is used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the design and dimensions as taught by Polk, because they provide the ability to have the user grip the handle and allow the user's hand to not slide off the handle and subsequent club. Thus, it appears to be an obvious design consideration which fails to patentably distinguish over Polk.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Polk in view of Daecher et al. and in further view of Winkler et al. (U.S. Patent Number 6,752,746).

Polk and Daecher et al. disclose the claimed invention except for the ribs inside the main body and cup. Winkler et al. teaches that it is known to use ribs as set forth in column 7, lines 40-55 to provide support and guidance for inserted weights. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the club as taught by Polk and Daecher et al., with ribs as taught by Winkler et al., since such a modification would provide the club with ribs for providing a support structure for the insertion of weights.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Polk in view of Daecher et al. and in further view of Ijiri et al. (U.S. Patent Number 5,330,193). Polk discloses the claimed invention except for the loop at the end of the handle. Ijiri teaches that it is known to use a loop at the end of a handle as set forth in column 6, lines 10-17, to secure the wrist to the club and to prevent it from slipping off during use. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the club as taught by Polk, with a loop as taught by Ijiri et al., since such a modification would provide the club with a loop for providing a secure fastening of the club to a user.

### ***Conclusion***

The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

### **Certificate of Mailing**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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(Date)

Typed or printed name of person signing this certificate:

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I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. ( ) \_\_\_\_\_ - \_\_\_\_\_ on \_\_\_\_\_.  
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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

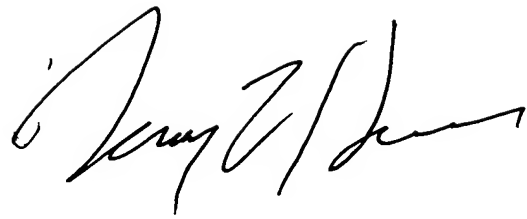
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Foster and Dudley (US 275,637), Reach (US 295,429), and Randall (US 596,543) all make references to clubs that weight can be added into for exercise and/or physical use. Patent JP 10,219,987 makes reference to injection molding and having walls of a minimum thickness. Edmonds (US 4,279,416) and Dantolan (US 6,228,002) make references to a "bee-hive" design and Dunn (US 5,484,361) makes a reference to a loop at the end of the handle for securing the wrist to the article in use.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arun S. Chhabra whose telephone number is 571-272-7330. The examiner can normally be reached on M-F 8:30-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on 571-272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Gregory L. Huson". The signature is fluid and cursive, with the first name "Gregory" being more prominent than the last name "Huson".

GREGORY L. HUSON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700